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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/669,760	09/25/2003	Robert Baseman	YO9-99-496 (00280588BA)	4384
30743	7590	06/27/2005	EXAMINER	
WHITHAM, CURTIS & CHRISTOFFERSON, P.C. 11491 SUNSET HILLS ROAD SUITE 340 RESTON, VA 20190			MEINECKE DIAZ, SUSANNA M	
			ART UNIT	PAPER NUMBER
			3623	

DATE MAILED: 06/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/669,760

Applicant(s)

BASEMAN ET AL.

Examiner

Susanna M. Diaz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 April 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20,22,24 and 25 is/are pending in the application.
4a) Of the above claim(s) _ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 20,22,24 and 25 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This Final Office action is responsive to Applicant's response filed April 13, 2005.

Claims 21, 23, and 26-28 have been cancelled.

Claims 20, 22, 24, and 25 are presented for examination.

2. The previously pending claim objection is withdrawn in response to Applicant's amendment of claim 25.

The previously pending rejection under 35 U.S.C. § 101 is withdrawn in response to Applicant's amendment of claim 20.

Response to Arguments

3. Applicant's arguments with respect to claims 20, 22, 24, and 25 have been considered but are moot in view of the new ground(s) of rejection.

Applicant requests the full URL used to access the Cohen article (page 5 of Applicant's response). Examiner has provided a PDF version of the Cohen article, which includes all referenced figures.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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5. Claims 20, 22, 24, and 25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Independent claim 20 has been amended to specify that the recited method is “performed on a computer”; however, the original disclosure does not expressly indicate which, if any of the recited, steps are “performed on a computer.” While there is mention of use of an expert system to perform certain calculations in the specification, these calculations do not include the particular steps recited in claims 20, 22, 24, and 25. For example, the optimization techniques listed as ‘a’, ‘b’, and ‘c’ in claim 20 are described on pages 14-15 of the specification and there is no mention of use of a computer to carry out these optimization techniques. Therefore, use of a computer to perform the method recited in claims 20, 22, 24, and 25 is deemed to present new matter. Please point out excerpts from the original disclosure that support these amendments or amend the claims in accordance with the original disclosure.

Independent claim 20 has been amended to recite that the optimization techniques listed as ‘a’, ‘b’, and ‘c’ are all performed; however, it is not clear how techniques ‘a’ and ‘b’ are interrelated. Furthermore, if both techniques are performed simultaneously, as recited in ‘c’, then are techniques ‘a’ and ‘b’ performed twice (i.e., once separately and then each together as part of the simultaneous optimization)? In other words, are all three optimizations performed or is technique ‘c’ an alternative to

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carrying out 'a' and/or 'b'? Also, are the supply chain design and ownership structure of technique 'c' the same as the supply chain design and ownership structure recited as part of techniques 'a' and 'b'? Furthermore, techniques 'a', 'b', and 'c' are not specifically referenced anywhere in the specification beyond pages 14-15; therefore, it is unclear what the metes and bounds of each technique are. Also, when all three techniques are performed (as recited in the claims), what is the scope of analysis performed in conjunction with all three techniques? The Examiner has looked toward the specification for clarification; however, description of these techniques is only found under the "Extended Supply Chain Design" section (pages 14-16). While it is generally stated that these techniques may all be performed, it is never explained *how* they are performed or what is entailed. Therefore, Applicant's original disclosure is seen as lacking the adequate written description required to convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

6. Claims 20, 22, 24, and 25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Independent claim 20 has been amended to recite that the optimization techniques listed as 'a', 'b', and 'c' are all performed; however, it is not clear how

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techniques 'a' and 'b' are interrelated. Furthermore, if both techniques are performed simultaneously, as recited in 'c', then are techniques 'a' and 'b' performed twice (i.e., once separately and then each together as part of the simultaneous optimization)? In other words, are all three optimizations performed or is technique 'c' an alternative to carrying out 'a' and/or 'b'? Also, are the supply chain design and ownership structure of technique 'c' the same as the supply chain design and ownership structure recited as part of techniques 'a' and 'b'? Furthermore, techniques 'a', 'b', and 'c' are not specifically referenced anywhere in the specification beyond pages 14-15; therefore, it is unclear what the metes and bounds of each technique are. Also, when all three techniques are performed (as recited in the claims), what is the scope of analysis performed in conjunction with all three techniques? The Examiner has looked toward the specification for clarification; however, description of these techniques is only found under the "Extended Supply Chain Design" section (pages 14-16). While it is generally stated that these techniques may all be performed, it is never explained *how* they are performed or what is entailed and undue experimentation would be required by one of ordinary skill in the art to make and/or use Applicant's intended invention. Therefore, the subject matter of claims 20, 22, 24, and 25 was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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8. Claims 20, 22, 24, and 25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Independent claim 20 has been amended to recite that the optimization techniques listed as 'a', 'b', and 'c' are all performed; however, it is not clear how techniques 'a' and 'b' are interrelated. Furthermore, if both techniques are performed simultaneously, as recited in 'c', then are techniques 'a' and 'b' performed twice (i.e., once separately and then each together as part of the simultaneous optimization)? In other words, are all three optimizations performed or is technique 'c' an alternative to carrying out 'a' and/or 'b'? Also, are the supply chain design and ownership structure of technique 'c' the same as the supply chain design and ownership structure recited as part of techniques 'a' and 'b'? Furthermore, techniques 'a', 'b', and 'c' are not specifically referenced anywhere in the specification beyond pages 14-15; therefore, it is unclear what the metes and bounds of each technique are. Also, when all three techniques are performed (as recited in the claims), what is the scope of analysis performed in conjunction with all three techniques? The Examiner has looked toward the specification for clarification; however, description of these techniques is only found under the "Extended Supply Chain Design" section (pages 14-16). While it is generally stated that these techniques may all be performed, it is never explained *how* they are performed or what is entailed.

Claims 22, 24, and 25 are dependent from claim 20 and therefore inherit the same rejection.

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Appropriate clarification and/or correction is required.

9. *Because claims 20, 22, 24, and 25 are so indefinite, no art rejection is warranted as substantial guesswork would be involved in determining the scope and content of these claims. See In re Steele, 305 F.2d 859, 134 USPQ 292 (CCPA 1962); Ex parte Brummer, 12 USPQ 2d, 1653, 1655 (BdPatApp&Int 1989); and also In re Wilson, 424 F.2d 1382, 165 USPQ 494 (CCPA 1970). Prior art pertinent to the disclosed invention is nevertheless cited and applicants are reminded they must consider all cited art under Rule 111(c) when amending the claims to conform with 35 U.S.C. 112.*

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Robinson et al. --- Discloses a supply chain design method that takes into account supply chain network design problems.

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susanna M. Diaz whose telephone number is (571) 272-6733. The examiner can normally be reached on Monday-Friday, 10 am - 6 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (571) 272-6729. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Susanna M. Diaz
Primary Examiner
Art Unit 3623

June 22, 2005